

Exhibit 5



Revised Accelerated Examination Program and Petition to Make Special Procedures

Office of Patent Legal Administration

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Revised Accelerated Examination (AE) Program and Petition to Make Special Procedures *Overview*

- Effective August 25, 2006, the following will be revised:
 - Requirements for filing petitions for accelerated examination, and other petitions to make special, and
 - Procedures set forth in MPEP 708.02 (8th Edition) for processing and examining these special cases.
- **GOAL:** to achieve a final decision by the examiner within 12 months from the filing date of the application
- See *Changes to Practice for Petitions in Patent Applications to Make Special and for Accelerated Examination*, 71 Fed. Reg. 36323 (June 26, 2006) (notice) available at <http://www.uspto.gov/web/offices/pac/dapp/ogsheet.html>
- MPEP 708.02 (8th Edition) will be revised in due course to reflect the changes.



Revised Accelerated Examination (AE) Program and Petition to Make Special Procedures *Overview*

- The new requirements apply to all petitions to make special. Thus, a uniform practice will be established.
 - Except: Petitions on the basis of health, age and the Patent Prosecution Highway (PPH) pilot program
- If the petition meets the requirements set forth in the notice,
 - The application will be granted special status under the revised AE program, and
 - The new processing and examination procedures will apply to the application.



Revised Accelerated Examination (AE) Program and Petition to Make Special Procedures *Effective Date Provision: 8/25/06*

- **On or after August 25, 2006**
 - **Any petition for accelerated examination, and any other petition to make special (except petitions based on applicant's health or age or the PPH pilot program) must meet the requirements set forth in the notice.**
 - **For example, the petition and application must be filed electronically via EFS or EFS-Web.**
 - **Petitions to make special filed before 8/25/06 need only comply with the previous requirements set forth in MPEP 708.02 (8th Edition).**
 - **The application will be processed and examined using the previous procedures set forth in MPEP 708.02 (8th Edition).**
 - **Petitions for the revised AE program will not be accepted before 8/25/06.**



Revised Accelerated Examination (AE) Program and Petition to Make Special Procedures *Summary*

- The revised AE program will allow applicants who desire quick patent protection for their inventions a way:
 - to receive a final patentability decision by the examiner within 12 months; and
 - to choose which applications they want to advance for examination.
- In order to meet the 12-month goal, an applicant will be required to provide additional information with the petition for AE, and comply with revised procedures throughout the examination process, to assist the examiner in expeditiously arriving at a final disposition.



Revised Accelerated Examination (AE) Program and Petition to Make Special Procedures *Summary - Benefits for Applicants*

- **Expedited handling throughout the patent application process, including:**
 - **Office of Initial Patent Examination (OIPE);**
 - **Examination;**
 - **Post-appeal process; and**
 - **Patent issue process.**
- **Earlier and better interactions with the examiner.**
- **More participation in clarifying and focusing the issues during the prosecution.**



Revised Accelerated Examination (AE) Program and Petition to Make Special Procedures *Filing Requirements*

- **The application must be filed with:**
 - **The petition to make special (form PTO/SB/28 will be made available prior to 8/25/06); and**
 - **The fee under § 1.17(h), or a statement that the claimed subject matter is directed to environmental quality, energy, or countering terrorism (no fee required, see §1.102(c)(2)).**
- **The application must be complete under § 1.51 and in condition for examination upon filing.**
 - **For example, the application must include the filing fees and an executed oath or declaration under § 1.63.**



Revised Accelerated Examination (AE) Program and Petition to Make Special Procedures *Filing Requirements (Cont'd)*

- The application, petition, and required fees must be filed electronically via EFS or EFS-Web.
- The application must contain:
 - 3 or fewer independent claims; and
 - 20 or fewer total claims.
- The claims must be directed to a single invention.
- The application must not contain any multiple dependent claims.



Revised Accelerated Examination (AE) Program and Petition to Make Special Procedures *Filing Requirements (Cont'd)*

The petition* (form PTO/SB/28) must include:

- A statement that applicant will agree to make an election without traverse in a telephonic interview;
- A statement that applicant will agree to have an interview when requested by the examiner;
- A statement that applicant will agree not to separately argue the patentability of any dependent claim during any appeal;
- A statement that a pre-examination search was conducted; and
- An accelerated examination support document (ESD).

*Applicant should contact the Office if a decision is not received by applicant after three months from the filing of the petition.



Revised Accelerated Examination (AE) Program and Petition to Make Special Procedures *Filing Requirements: Pre-examination Search*

- The statement that a pre-examination search was conducted must include:
 - An identification of the field of search by U.S. class and subclass and the date of the search, where applicable; and
 - For database searches,
 - the search logic or chemical structure or sequence used as a query;
 - the name of the file or files searched;
 - the database service; and
 - the date of the search.



Revised Accelerated Examination (AE) Program and Petition to Make Special Procedures *Filing Requirements: AE Support Document*

The accelerated examination support document must include:

- An information disclosure statement (IDS) citing each reference deemed most closely related to the subject matter of each claim;
- An identification of where each limitation disclosed in the references is found.
- A detailed explanation of how each claim is patentable over the reference;
- A concise statement of utility of the invention;
- A showing of support for each claim limitation in specification and any parent application, including any means-plus-function limitations; and
- An identification of any cited references that may be disqualified as prior art under 35 U.S.C. 103(c).



Revised Accelerated Examination (AE) Program and Petition to Make Special Procedures *Processing and Examining Procedures*

- Once the application is granted special status, the application will be promptly taken up for action (e.g., within 2 weeks of petition decision), with special examining procedures set forth in the notice.
- The examiner will consider the AE Support Document and conduct a complete prior art search.
- Prior to mailing any first Office action rejecting claims,
 - A telephone interview will be conducted, unless an interview is deemed unlikely to overcome the rejection; and
 - A conference will be conducted in the USPTO to ensure the viability of the rejection(s).
- There will also be a conference before mailing any final Office action.



Revised Accelerated Examination (AE) Program and Petition to Make Special Procedures *Processing and Examining Procedures (Cont'd)*

- Office actions will have a shorter period for reply:
 - One-month (or 30 days) SSP for any action, other than a final rejection or allowance.
 - No extensions of time under § 1.136(a) permitted.
- Failure to timely file a reply will result in abandonment of the application.
 - Extensions of time are only available under § 1.136(b).



Revised Accelerated Examination (AE) Program and Petition to Make Special Procedures *Examining Procedures: Applicant's Reply*

- Any reply must be:
 - filed via EFS-Web;
 - complete, fully responsive; and
 - limited to the rejection(s), objection(s) and requirements made.
- An updated AE support document is required for any amended or newly added claims that are not encompassed by the previously-filed AE support document.
- The above requirements are imposed in order to be able to complete the examination within 12 months.



Revised Accelerated Examination (AE) Program and Petition to Make Special Procedures *Examining Procedures: Applicant's Reply (Cont'd)*

- **The Office will treat any amendments (including after-final amendments and RCE submissions) as not being fully responsive if the amendment:**
 - **Exceeds the 3/20 claim limit;**
 - **Presents claims to a non-elected invention;**
 - **Presents claims not encompassed by the pre-examination search; or**
 - **Presents claims requiring an updated AE support document, which is not submitted.**



Revised Accelerated Examination (AE) Program and Petition to Make Special Procedures *Post-Allowance Procedures*

- **While the mailing of a notice of allowance is the final disposition for purposes of the Office's 12 month goal, in order for the application to be expeditiously issued as a patent, applicant must:**
 - **Within one month, pay the issue fee (and any outstanding fees due) and return the form PTOL-85B (Part B of the Notice of Allowance and Fee(s) Due); and**
 - **Not file any post-allowance papers that are not required by the Office.**



Revised Accelerated Examination (AE) Program and Petition to Make Special Procedures *Appeal Procedures*

- **While the mailing of a final rejection is the final disposition for purposes of the Office's 12 month goal, in order for the application to be expeditiously forwarded to the Board of Patent Appeals and Interference for a decision, applicant must:**
 - **Promptly file the notice of appeal, appeal brief, and appeal fees; and**
 - **Not request a pre-appeal brief conference (which would not be of value because a conference would already have been conducted).**



Revised Accelerated Examination (AE) Program and Petition to Make Special Procedures

The Office's Twelve-Month Goal

- **The objective is to achieve a final decision by the examiner within 12 months from the filing date of the application.**
- **The 12-month goal is successfully achieved when one of the following final dispositions occur:**
 - **Notice of Allowance;**
 - **Final Office action;**
 - **Notice of appeal;**
 - **Request for Continued Examination (RCE); and**
 - **Abandonment.**



Revised Accelerated Examination (AE) Program and Petition to Make Special Procedures *The Office's Twelve-Month Goal (Cont'd)*

- **The final disposition may occur later than 12 months in certain situations.**
 - **For example, if there is a secrecy order, national security review, interference, petition under §§ 1.181, 1.182, or 1.183, or non-compliant or not fully responsive amendment.**
- **Any failure to meet the goal, or other issues relating to this goal, are neither petitionable, nor appealable.**



Revised Accelerated Examination (AE) Program and Petition to Make Special Procedures *Eligible Applications*

- **Any non-reissue utility or design application filed under 35 U.S.C. 111(a) on or after the effective date is eligible.**
 - **Not eligible: plant applications, international applications including applications entering the national stage under 35 U.S.C. 371, and reissue applications.**



Revised Accelerated Examination (AE) Program and Petition to Make Special Procedures *Summary*

Quality Patents in Less Time

- In exchange for quick examination, examiners will receive more focused and detailed information about the invention and the closest prior art from applicants.
- The upfront disclosure by applicants will help examiners to more quickly make the correct decision on whether a claimed invention is patentable.



Revised Accelerated Examination (AE) Program and Petition to Make Special Procedures *Additional Information*

- Additional information is available on the USPTO's Internet web site at <http://www.uspto.gov/web/offices/pac/dapp/ogsheet.html>
- For more information, please contact the Office of Patent Legal Administration (OPLA) at (571) 272-7701, or e-mail to PatentPractice@USPTO.gov, or contact Pinchus M. Laufer at (571) 272-7726.



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Thank you