Accelerated Examination

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Overview

- The Basics
- Petition for accelerated examination
- Pre-examination search
- Examination Support Document
- Patent Application
- Review of the Petition
- Special Examining Procedures
- Observations on Accelerated Examination Practice
- Conclusion
The Basics

- Applicant gets accelerated examination by filing
  - A (non-PCT, non-reissue) utility or design application, even a continuation or divisional, that is complete and ready for examination
  - A petition for accelerated examination
- Application is limited to a single invention and a limited number of claims
- Application must be complete and ready for examination when filed
The Basics

- Petition must include a prior art search and an analysis of the most closely related prior art
- Deadlines up to disposition are shortened to one month and extensions of time are not automatic
- Expect decision on petition within 2 months
- Expect disposition within 12 months
Petition for accelerated examination

- Petition must be filed together with a complete patent application
- Petition must be filed electronically with application
  - A petition fee is required ($130) unless claims are directed to environmental quality, conservation or development of energy, or countering terrorism
- Petition must include an accelerated examination support document ("ESD")
Petition for accelerated examination

Petition must state that applicant:
- Will elect one invention
- Will agree to an examiner interview, even before first action
- Will only appeal rejections of the independent claims
- Has conducted a pre-examination search
Petition for accelerated examination

Note: for design patent applications, an easier “expedited examination” is available
- Does not require an ESD: *Pre-examination search and IDS (list of references) is required*
- Request may be filed in person or by mail
- Request may be filed after application is filed
- Request is expensive ($900)
Petition for accelerated examination

Note: Petition to make special could also be based on applicant’s health or age or under the PPH (patent prosecution highway) program
- Not required to fulfill any of the accelerated examination program requirements
- No 12 month goal in USPTO
- No shortened deadlines to respond to actions
Pre-examination search

The petition must describe the scope of search:
- Field of search by US class and subclass and the date of search
- For database searches:
  - the query (e.g., search logic or chemical structure or sequence)
  - file or files searched
  - name of the database service
  - date of search
Pre-examination search

Search must be thorough
- Must search
  - US patents and patent application publications
  - Non-US patent documents
  - Non-patent literature: *e.g., text search of foreign patent documents that includes the sources required under the PCT minimum documentation requirements*
  - Unless the applicant justifies searching less
Pre-examination search

Search must be thorough
- Must be directed to the claimed invention
  • encompass all limitations of all claims
  • giving the claims the broadest reasonable interpretation
- Must encompass features that may be claimed
  • In prosecution, an amendment to the claims (including any new claim) that is not encompassed by the search or an updated ESD will be treated as not fully responsive and will not be entered
Pre-examination search

- Search must be thorough
  - A search report from a non-US patent office may satisfy part of the search requirement
  - Need not search claim limitations that applicant expressly admits are well known in the art
Pre-examination search

- Patent attorney or agent signing petition represents it is presented in good faith
  - Statement in support of a petition to make special must be based on a good faith belief that the pre-examination search was conducted in compliance with program requirements
Examination Support Document (ESD)

As to the claims, ESD must
- State the utility of the invention as defined in each independent claim
  - Unless application is a design application
- State where in the specification each claim limitation is supported
  - Show support in any application for which benefit is claimed
  - If application is a continuation-in-part, some claims might not have support in all priority documents
  - Means- or step-plus-function limitations have to be identified:
    Support must be shown for multiple embodiments, if any
As to the claims, ESD must
   - Explain how each claim is separately patentable over the references
     • Can address a dependent claim by conceding it is not patentable if base claim is not patentable
Examination Support Document (ESD)

As to the references, ESD must

- Be accompanied by an IDS (information disclosure statement) citing only those references the applicant finds “most closely related” to each claim
  - Must cite the reference that discloses the most limitations in each independent claim
  - Must cite any reference that discloses a limitation of a claim not shown by other references
  - Must cite any reference that establishes *prima facie*, alone or with other information, that a claim is unpatentable
  - Do not cite cumulative references
Examination Support Document (ESD)

As to the references, ESD must

- State where in those references each claim limitation is disclosed
  - Including limitations that are not the reason for citing the reference
- Identify any reference that may be disqualified as commonly owned subject matter
Examination Support Document (ESD)

Correcting defective petition or ESD

- Applicant gets one opportunity, one month, to correct defects (petition is “dismissed”)
- Opportunity does not apply to applications that are not ready for examination on filing (petition is “denied”)

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Patent Application

- Application must be complete, correct, and ready for examination
- Application must include (all in compliance with the applicable rules)
  - Payment of all fees
  - Declaration signed by all inventors
  - Formal drawings (if any drawings are required)
  - Title and abstract
  - No preliminary amendment
  - Translation of non-English priority documents or specification, if any
  - Electronic submissions of sequence listings, large tables, or computer listings
  - Foreign priority claim, if any
  - Domestic benefit claims, if any
Patent Application

Application should include
- Suggested classification, by US class and subclass

Claims must be directed to a single invention
- Applicant must elect one invention without traverse in a telephone interview

Claims are limited
- No more than 3 independent claims
- No more than 20 claims
- No multiple dependent claims
Patent Application

- Application must be a utility or design application
  - May be a continuation, divisional, or continuation-in-part
  - Not a plant application
  - Not an international (PCT) application or a national stage of a PCT application
  - May be a by-pass continuation claiming benefit of a PCT application
  - Not a reissue application
  - Not a conversion of provisional to nonprovisional application
Review of the Petition

Petition is carefully examined for strict compliance with all the requirements.

If petition search or ESD are insufficient, petition will be dismissed:
- Dismissal will indicate what needs to be done and generally includes suggestions, e.g., suggested searches.
- Applicant will get one opportunity (one month) to perfect petition or ESD.
- Can generally telephone to confirm with USPTO specialist that planned corrections will perfect the filing.
Review of the Petition

If application is not in compliance and ready for examination, petition will be denied with no opportunity to cure

- Common application defects causing petition to be denied
  - Presence of preliminary amendment, more than 3 independent claims, more than 20 total claims
  - Filing on paper
  - Defect causing Office of Initial Patent Examination (OIPE) to mail a defect notice
  - Improper benefit claim to a prior application
  - Presence of petition for a non-signing inventor
Review of the Petition

- Petition will be decided in 1-3 months, generally in 2 months
- If petition is denied --
  - Application is handled with no special status
  - Applicant can try again --
    • Correct the defects and file a continuation application with the petition
    • Amend claims in original application to avoid double patenting rejection in continuation
- If petition is granted, special accelerated examining procedures apply
Special Examining Procedures

- The examiner will pick up the application almost immediately
- The examiner considers the ESD
- The examiner conducts a prior art search
Special Examining Procedures

The examiner will call the applicant for a telephone interview to discuss prior art and any potential rejections or objections

- Goal is to clarify and if possibly resolve the issues in interviews
- This may happen several times
- Examiners are encouraged to resolve issues in interviews
- Examiner will not issue written action unless interview conducted or determination made that interview unlikely to result in allowable application
- Applicant must submit a written, complete and accurate summary of the substance of every interview
Special Examining Procedures

- A conference will be held within the USPTO before any written action with rejections is sent to applicant.
- The applicant’s time to reply to a non-final action is only one month.
  - No automatic extensions of time are available.
  - Extensions of time are available “only for sufficient cause”.
- Applicant must file all papers electronically.
  - Including references.
Special Examining Procedures

🛠 Replies must be limited to the rejections, objections and requirements made in the action

🛠 A reply is not fully responsive if

- It results in more than 3 independent claims or more than 20 claims in all
- It presents a claim to a non-elected invention
- It presents a claim not within the scope of the pre-examination search
- It presents a claim requiring an updated ESD, and updated search, or both, which are not submitted with the reply
Special Examining Procedures

- Failure to file a fully responsive reply on time results in abandonment of the application
  - If examiner finds reply to be bona fide attempt to advance prosecution, examiner may give applicant 30 days to provide responsive reply
  - Applicant cannot avoid abandonment by withdrawing from special status
    - Applicant can only file a continuation before abandonment of accelerated examination application
Special Examining Procedures

Information Disclosure Statements (IDSs)

- The IDS supporting the petition must be filed with the ESD
- The IDS supporting the petition must include only the “most closely related” references
- Other references can be submitted in other IDSs
  - Not addressing a reference in an ESD is a representation by applicant that the reference is not “most closely related”
- Applicant must supplement the ESD to account for any later found reference that is closer to a claim than references previously addressed in an ESD
Special Examining Procedures

Final actions
- Reviewed in conference (3 examiners) before being sent
- Normal (3 month) time to reply or file notice of appeal applies
- Automatic extensions are available
- No additional time given for reply that is not fully responsive
Special Examining Procedures

Appeals before the Board of Patent Appeals and Interferences

- Board will treat appeal as special if applicant is diligent
  - Applicant must file the notice of appeal, appeal brief and appeal fees promptly
  - Applicant must not request pre-appeal brief conference
- After appeal, USPTO will continue to treat application under accelerated examination program
Special Examining Procedures

Issuance

- To have the patent issue promptly, the applicant must
  - Pay all required fees within one month of the notice of allowance
  - File no post-allowance papers that are not required by the examiner
Special Examining Procedures

Goal of USPTO is disposition within 12 months of application filing
- Notice of allowance
- Final rejection
- Abandonment
- Notice of appeal
- Request for Continued Examination (RCE)
  - After an RCE, the application continues to be special
  - USPTO goal is a disposition within 12 months of the RCE filing

A failure by the USPTO to meet the 12-month goal is not subject to review
Observations on Accelerated Examination Practice

Filing Application

- Check drawings after upload to USPTO
  - Even slight informalities in drawings will cause petition to be denied
  - Smudge marks, illegible text, improper margins have all caused denials
  - Even drawings accepted in parent applications have been rejected
- Check claims for benefit of prior applications for strict compliance with rules
  - Failure to identify prior application as continuation, divisional or continuation-in-part has caused denials
Observations on Accelerated Examination Practice

**Searches**

- Searches are best done by search firms specializing in accelerated examination searches
  - Work product will be in a useful form
  - Work product will include information required for petition
  - Search firm will generally update search if USPTO finds search inadequate
- Start with claims having the limitations the applicant really wants and has good reasons to believe will yield a patentable combination
  - Iterating claim drafting and searching until a set of good claims is found is very expensive
Observations on Accelerated Examination Practice

Examination Support Document (ESD)

- The ESD requires much care
  - Identifying the most relevant art
  - Finding the claim limitations in the most relevant art
  - Explaining why the claims are patentable over the art
- Claim limitations must be given their “broadest reasonable interpretation”
- This can cost as much as the preparation of the application itself, or more
Observations on Accelerated Examination Practice

Prosecution
- It moves very quickly
- It moves faster than you expect
- It really moves fast
- The inventors and client must be ready to assist and make decisions quickly

The results are satisfying
- The client gets the patent promptly, sometimes in less than 6 months
- The patent can be asserted with confidence
Conclusion

- Accelerated examination has been adopted slowly
- Costs and risks were immediately apparent
  - Prior art search and analysis are expensive
  - Accelerated prosecution is stressful
  - Costs of preparation and prosecution are compressed into 6-10 months
  - Risk of inequitable conduct is manifest
    - Unlike usual practice, it is necessary to characterize the art
    - Characterization cannot be, or appear to be, misleading
Conclusion

Benefits are being recognized
- Total cost to patent can be lower than usual practice
  - Everyone is focused on project throughout process
  - No wasted time getting back up to speed after long delays by patent office or attorney
  - Inventor is likely still employed by assignee and still interested in the invention
  - Examiners tend to be well qualified and cooperative
  - Examiners are motivated to get to correct disposition as efficiently as possible
  - Examiners want to resolve issues in interviews rather than by paper exchange
  - Thus, all effort is directed to identifying allowable claims
Conclusion

Benefits are being recognized
- Process generates knowledge
- Patent generally issues in less than 12 months
  - Average time from filing to issue (as of February 2009) was 296 days
  - Good for technologies with short lifetimes
  - Good for claims with current targets
  - Good for growing portfolios rapidly
  - Good for patent pools where essential patents yield royalties
  - Good to know that US patent will issue before deciding to file in a publication jurisdiction
  - Bad for patent term adjustment (PTA)
Conclusion

Benefits are being recognized
- Can put key continuing applications into accelerated examination
- Can get a claim from or based on a pending application to issue quickly
- Can get coverage for a new technology in time to establish a position
  - To justify an investment
  - To justify a valuation of a business
  - To frighten competitors
Conclusion

Benefits are being recognized

- The patent can be made resistant to reexamination
  - A patent can be reexamined only if the requestor shows a substantial new question of patentability (SNQ)
    - *If the question is one addressed in the original examination -- even if incorrectly -- reexamination is not available*
  - One normally avoids explaining why claims are allowable
  - In accelerated examination, this is unavoidable
    - *The applicant can try to anticipate the attacks that will be made and address them in the ESD*
  - A patent that cannot be reexamined is much more valuable than one that can be
Questions?
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