

Proactive Steps To Expedite Patent Issuance

Friday, February 02, 2007 --- Almost everyone in the patent community agrees that it takes too long to move a patent application through prosecution to issuance. In many fields, the useful life of the technology can pass before the patent even issues.

The U.S. Patent and Trademark Office (PTO) has made various efforts to speed things up on its end, including setting goals for certain actions and hiring more patent examiners.

However, patent owners know well that the wait for a patent can still be too long to meet the goals of their businesses. Consider applying the following proactive steps to patent applications needing expedited attention.

First, review your filing strategy to ensure that it is not a part of the problem. Many corporate patent filing strategies are designed to delay examination and issuance so as to defer incurring fees on inventions which may not prove marketable.

For example, filing a provisional application prior to a regular application may provide a bit of cost savings over a regular application, deferring remaining costs for a year.

Also, sending the application through the Patent Cooperation Treaty (PCT) process allows patent owners to defer the costly foreign filing decisions for 30 months from the earliest priority application date or more (depending on the country).

If your company's standard filing strategy involves filing provisional and PCT applications before filing a regular U.S. application, make an exception for inventions having a shorter useful life (perhaps by way of a checkbox on an invention disclosure form).

If you are interested in filing the patent application internationally, you may be able to expedite examination by filing a PCT application designating the U.S. as the International Search Authority (ISA) concurrently with a regular U.S. application.

In this situation, the PCT rules require the search report for the PCT application to be established within 9 months of the priority date (or later if the ISA does not receive the search copy within 6 months)—much quicker than the 20 months or more a first office action typically takes. See PCT Rule 42.1.

Once a U.S. examiner has performed the search, contact either the examiner who performed the search or that examiner's Supervisor Primary Examiner (SPE) (who likely still has not allocated the corresponding U.S. case to an examiner) to inform them that there is a corresponding U.S. case. While this technique may not work in particularly backlogged Group Art Units (GAUs), other GAUs may appreciate the opportunity to issue a first office action with greater expediency.

Draft the patent application with an eye toward readability and ease of consideration by the patent examiner. While examiners typically focus on the oldest cases in their queues, they do have some discretion as to which cases to handle first.

For example, an examiner is more likely to pick up a case having a single claim set of 10 claims than a case having hundreds of claims of varying scope. Also, multiple claim sets of widely varying scope are more likely to incur the delay associated with a requirement restricting the application into multiple divisional applications.

After agreement is reached on the single claim set, propose to the examiner that additional claims with similar patentable language (but of varying scope) be added before the Notice of Allowance.

In an important case, multiple applications can be filed, one with a single claim set and others with numerous sets of claims; or continuation applications can be filed, subject, of course, to whether the PTO implements rules it is currently considering to limit the number of continuation applications allowed.

Examiners also review the detailed technical description in the patent application. Make their jobs easier where it makes sense. Draft the specification in a clear, concise manner. Be selective in your use of terminology, avoiding vague terms throughout.

Where appropriate, explain terminology used in the field and the needs that can be addressed by the invention to convince the examiner of the significance (i.e., nonobviousness) of the invention. While exceedingly long specifications may be needed for some technologies and can have benefits, many inventions can be described along with alternative embodiments without running on for hundreds of pages.

Consider the PTO's new Accelerated Examination (AE) process. This process allows applicants to obtain a final decision (e.g., a Final Office Action) on an application twelve months from the filing date – a process that typically takes 2-3 years or longer.

The applicant must comply with a laundry list of procedural requirements, including the daunted "Accelerated Examination Support Document" or AESD.

The AESD requires the applicant to report the results of a thorough search of U.S., foreign, and non-patent documents, cite each reference “deemed most closely related to the subject matter of each of the claims,” and for each reference cited, identify “all the limitations in the claims that are disclosed by the reference specifying where the limitation is disclosed in the cited reference.” 71 Fed. Reg. 36323, 36325 (June 26, 2006).

Further, an argument of patentability must be presented and must address obviousness. While these requirements may sound benign to a layperson, most patent practitioners appreciate the risks. The statements made in the AEDS may result in the patent being confined to a narrower interpretation of its teachings.

Further, though references may be identified and distinguished with care, litigators will undoubtedly second-guess the characterizations and accuse the patentee of misleading the PTO, giving a court the ability to render the patent unenforceable.

Add to this the mandatory waiver of arguing the separate patentability of dependent claims at the appeal stage, and most practitioners are ready to throw in the towel on Accelerated Examination for most situations.

In fact, there is no guarantee the PTO will reach a final decision within twelve months. The failure to do so is neither petitionable nor appealable.

The PTO has tried to soft-shoe the requirements of the AESD by saying that it will adopt a “rule of reason” when deciding whether to grant a petition for Accelerated Examination based on the AESD, and by promising the AESD is “not intended to be an exhaustive listing of every conceivable subjective interpretation of how a claim limitation may read on the reference.” See USPTO Accelerated Examination Webinar Presentation, available at http://www.uspto.gov/web/patents/accelerated/documents/ae_webinar_versio (image 35).

However, these assurances do not address the greater concerns of filling your file history with admissions and representations. So, if you prefer a clean file history without adding to the inevitable inequitable conduct challenges to your patent’s enforceability, AE may not be for you.

In fact, while the PTO has not released official numbers of petitions for AE filed since the August 25, 2006 launch, it indicates initial interest has been slow but steady (over 100 filings as of January, 2007) and that the AE process is a work in progress.

The real casualty of AE is the Petition to Make Special. With requirements much less stringent than that of AE, Petitions to Make Special based on manufacture, infringement, and other grounds were viable methods of improving your chances of expedited examination.

Unfortunately, the AE requirements will replace the Petition to Make Special

requirements for almost all grounds previously recognized (not including the grounds of the inventor's health and age or the Patent Prosecution Highway for Japan filers).

If patent protection in Europe is desired, you may wish to request expedited search and examination of the European patent application under the European Patent Office's PACE program.

No search, additional fee, or submission of references with explanations is required for an applicant to enter the PACE program. An indication of allowability of claims at the EPO stage may be conveyed to the U.S. examiner in an effort to expedite allowance.

One drawback of this strategy is that the decision of whether to incur the cost of validating in the various EPO cases arrives much earlier than under normal EPO search and examination procedures.

Fortunately, there are further proactive steps within normal prosecution at the PTO that can be taken to expedite issuance, some of which are highlighted by the requirements of AE.

Filing formal drawings, fees and the signed inventor declaration at the time of filing the application will avoid delays caused by receiving a Notice to File Missing Parts. To avoid delays associated with correction of application data, use an application data sheet (ADS) where appropriate.

If your application is directed to the field of business methods in GAU 705, an art unit notoriously backlogged, draft your patent claims to some technical aspect of the invention, such as a computer system integral to carrying out the method or an apparatus which is key to implementing the method.

Keeping your application out of GAU 705 will avoid the extremely long prosecution delays typical of that GAU, at least for the foreseeable future. Better yet, if aspects of the invention could be categorized under multiple GAUs, phone the SPE of each GAU prior to filing the application to assess their current backlogs and favor drafting claims directed to the GAU with the shortest backlog.

Once your application is finally picked up for examination and the PTO sends a first Office Action rejecting claims, quickly assemble your business, technical and legal personnel to consider the rejection and discuss the best approach for a reply.

Assess whether the claim scope is still optimal in view of any changes to the technology since filing the application. Conducting a telephonic or in-person examiner interview often saves significant time in resolving issues the examiner has with the patent application. Any written reply to the Office Action should be sent by facsimile, which will go directly to the Examiner's GAU and avoid a trip through the PTO paper mail.

In any event, do not hesitate to pick up the phone and contact the PTO at various stages during prosecution to track the progress of the case through the different departments and seek suggestions for helping to expedite the process. PTO examiners and other staff know the inner workings of the Office and may be the best source for help in expediting important patent applications.

--By Steven C. Becker, Foley & Lardner LLP

Steven C. Becker is a partner in the Intellectual Property Department of Foley & Lardner LLP, in its Electronics Practice Group. The views expressed herein are those of the author and do not necessarily reflect the views of Foley & Lardner LLP or its clients. This article is intended as a general overview of strategies which may or may not be applicable to any particular circumstances. Seek the advice of legal counsel before applying these strategies. The author can be contacted at sbecker@foley.com.