

Strategies for Expediting U.S. Patent Prosecution

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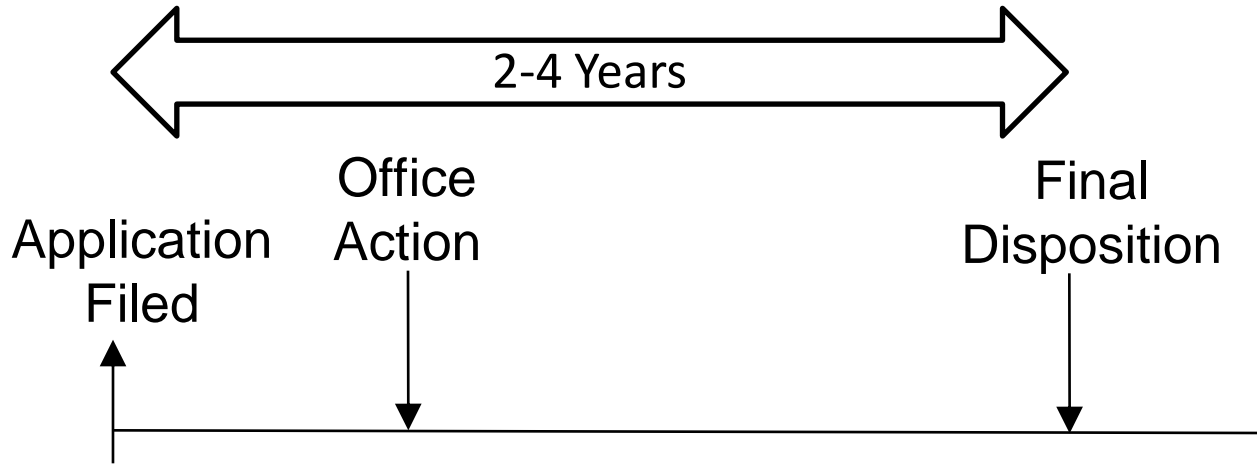
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Strategies for Expediting U.S. Prosecution

1. Petition to Make Special
2. Track One Prioritized Examination
3. Request for Accelerated Examination
4. First Action Interview Program
5. Patent Prosecution Highway (PPH)

“Normal” U.S. Prosecution Timeline



Let the ABPI Games Begin!

New Sport: “Patent Expediting”

Ease of filing

Cost

Applicability/Usage

Effectiveness

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Petition to Make Special

Applicant may accelerate prosecution by filing Petition with application

- Applicant's **health**
- Applicant's **age** (at least one inventor over 65 years)
- Claimed invention enhances **environmental quality**
- Claimed invention relates to conserving **energy sources**
- Claimed invention **counters terrorism**
- Claimed invention provides **cancer immunotherapy**

Petition to Make Special

Advantages: Free!

Faster

Concerns: Limited subject matter/people

How fast?

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Petition to Make Special Score Sheet

Ease of filing: 10

Cost: 10

Applicability/Usage: 2

Effectiveness: 5-6

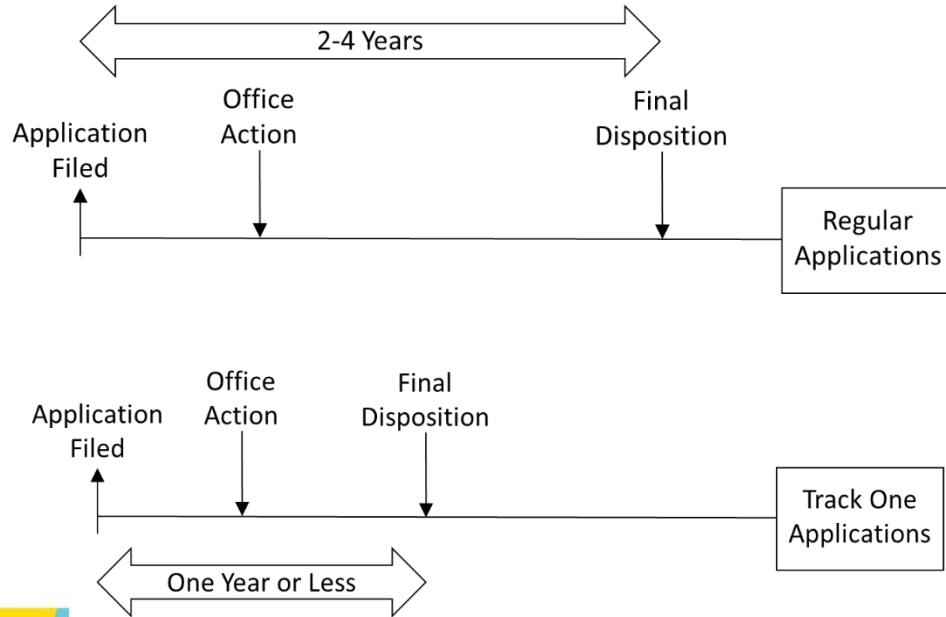
Reasonable Score, Potential Medal Contestant?

Track One Prioritized Examination



- “**Pay to Play**”: pay to jump to the front of the line
- Within one year of grant of petition, the USPTO issues a **Notice of Allowance** or a **Final Rejection**

Track One Prioritized Examination



Track One Eligibility

- Requires a **new U.S. utility or plant application**
 - Includes continuations and divisionals
 - Includes Requests for Continued Examination (RCEs)
- **NOT** available for:
 - PCT or national stage applications
 - Design, provisional, or reissue applications
- Limited to **10,000** applications per year
 - USPTO received **5,533** Track One applications through July 2016¹

¹ PTO Patent Dashboard, <http://www.uspto.gov/corda/dashboards/patents>

Track One Requirements

- Track One Petition Fee
 - One-time **\$4,000 processing fee (small business discounts available)**, in addition to standard filing, search, examination fees
 - Total filing fees: \$5,600 (small business discounts available)
- Imposes limitations on claim set
 - **30** or fewer **total** claims
 - **4** or fewer **independent claims**
 - **No multiple dependent claims**
- No extensions of time for responding to USPTO communications

Track One Benefits

Reduction in First Office Action Pendency and Overall Pendency

	Average Pendency (months)	
	Track One	Normal Examination
Filing to First OA	3.5	16.1
Filing to Final Disposition	6.9	25.6

Source: PTO Patent Dashboard, <http://www.uspto.gov/corda/dashboards/patents>

Track One Benefits

- **Rapidly build portfolio**, protect a key development, protect products with short lifecycles.
- **Reduced prosecution costs**
 - Track One applications average **1.5** Office Actions, compared **2.5** actions under normal examination²
 - No extensions-of-time available
- **Not subject matter or applicant limited**; just pay to play
- **Application allowed/denied before publication**

² PTO Patent Dashboard, <http://www.uspto.gov/corda/dashboards/patents>

Downsides of Track One

- Track One **front-loads costs** \$\$\$
 - May negatively impact research and development (R&D) and patent budgets
 - “Paying for speed”
- **Claim numbers** may reduce scope of claim coverage
- **Too fast??** May not want for applications in **developing technology areas** and/or **evolving legal issues (Section 101)**

Track One Score Sheet

- Ease of filing: 10
- Cost: 6
- Applicability/Usage: 10
- Effectiveness: 10

Front Runner, Medal Contender!

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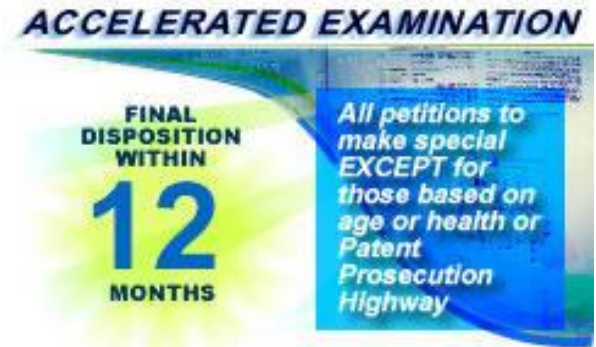
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Accelerated Examination

Petition-based program aiming to provide final disposition of applications within 12 months of filing.

“Applicant plays partial role of Examiner”



Accelerated Examination

- BEFORE requesting Accelerated Examination, Applicant must:
 1. Conduct a formal search of the prior art
 2. Submit Pre-Examination Search Document, itemizing searched databases and search terms; and
 3. Submit Accelerated Examination Support Document:
 - Identify claim elements that distinguish the “best” search results
 - Describe how claim elements differ from the best search results
 - Identify claim elements that do not distinguish the search results.

Accelerated Examination

- Applicant agrees to:
 - **Examiner interview** to discuss any outstanding issues arising in the examination process.
 - Limit claims to a **single invention** or agree to **elect without traverse** a single invention for examination.
 - Limit claims to **20 total claims** and **3 independent claims**.
 - No **extensions of time** when responding to USPTO communications.

Accelerated Examination Benefits

- USPTO intends to provide final disposition within 12 months
- Reduction in First Office Action Pendency and Overall Pendency

	Average Pendency (months)	
	Accelerated Examination	Normal Examination
Filing to First OA	5.77	17.3
Filing to Final Disposition	12.58	26.6

Disadvantages of Accelerated Examination

- **Costs** \$\$\$\$\$ Accelerated Examination Support Document may **exceed** cost to draft the application

Accelerated Examination Petition Fee: \$140

Professional Search: cost unknown

Preparing Accelerated Exam Support Document: cost unknown

- **Excessive admissions** on the record within the Accelerated Examination Support Document
- **Limited claim amendments**
 - Amendments must be within scope of initial search, or an updated search must be conducted and a new Accelerated Examination Support Document must be prepared

Accelerated Examination Score Sheet

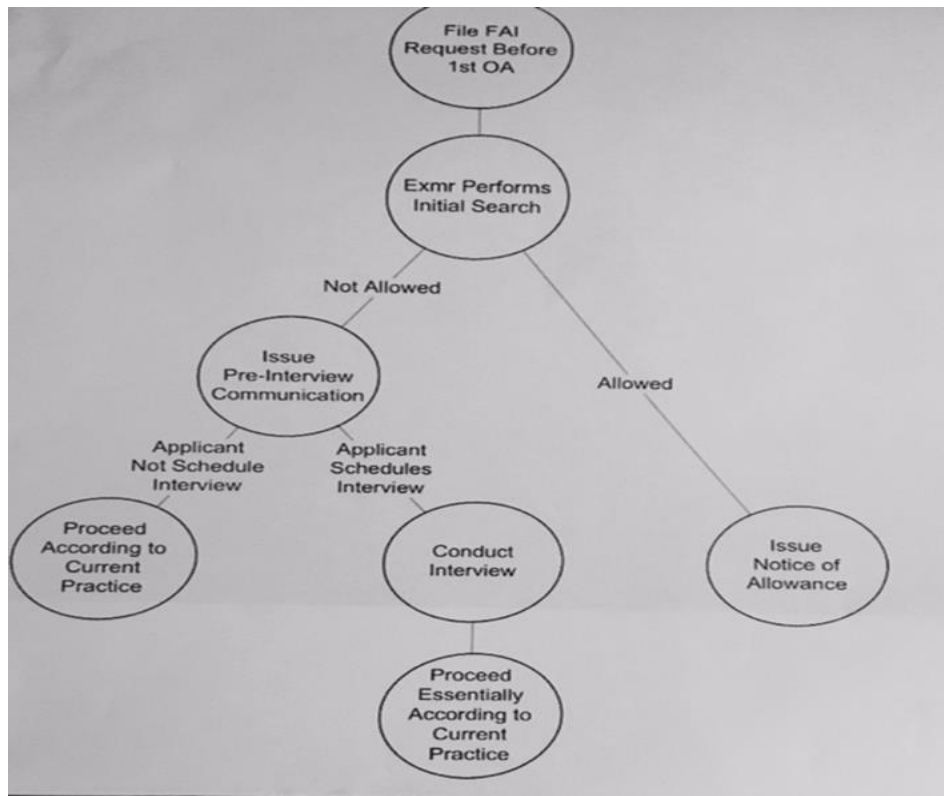
- Ease of filing: 0
- Cost: 0
- Applicability/Usage: 2
- Effectiveness: 3-5

Tumbles, falls, and retirement seems inevitable

First Action Interview (FAI) Program

- Program requiring Applicant to discuss with Examiner before 1st Office Action issues.
- Examiner performs preliminary search, and discusses with Applicant.

First Action Interview (FAI) Program



First Action Interview (FAI) Eligibility

- Utility application or national stage application
- 3 or fewer independent claims, 20 or fewer total claims
- No multiple dependent claims
- Must claim only a single invention
- Must file before 1st Office Action issues

First Action Interview (FAI) Program

- Benefits: Early communication with Examiner
First Action Allowance can occur
Free!
- Concerns: Vague “semi-rejections” from Pre-Interview Report
1st Office Action essentially makes rejection final
Does not really expedite prosecution
Very unpopular/underused, 0.2% usage.

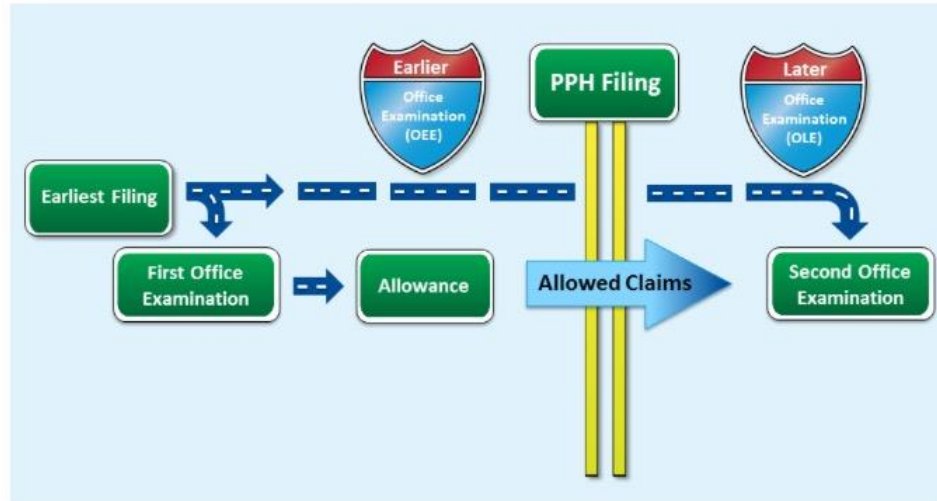
First Action Interview Score Sheet

- Ease of filing: 10
- Cost: 10
- Applicability/Usage: 2
- Effectiveness: 2

Disappointing finish, better luck for 2020!

Patent Prosecution Highway (PPH)

- System where claims allowable in the **Office of First Filing (OFF)** eligible for an **accelerated examination** in the **Office of Second Filing (OSF)**.



Patent Prosecution Highway (PPH)

A system that shares work between different Patent Offices



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PPH Eligibility

1. Related foreign application has **allowable subject matter**
2. Foreign application and US application **share common earliest priority date**; and
3. **Substantive Examination not started** in USPTO.

Required Documents for PPH

- Applicant must submit:
 - PPH Request
 - **Claims correspondence table** indicating how all claims correspond to allowable claim(s)
 - Copy of last Office Action issued before Decision to Grant or latest PCT work product
 - Information Disclosure Statement (IDS) listing the documents cited by the Foreign Patent Office or PCT
- No special PPH filing fee!

PPH Substantive Examination

- USPTO has substantive examination.
- Substantive examination begins ~ 6 months from filing.
- Time extensions available.

Patent Prosecution Highway (PPH)

- Advantages: Examination begins within few months.
1st Action Allowances not uncommon
- Concerns: Foreign applications with narrow claims
Not useful for U.S. only applications

Patent Prosecution Highway (PPH) Score Sheet

- Ease of filing: 8
- Cost: 10
- Applicability/Usage: 5
- Effectiveness: 8

Solid Performance!

Summary and Final Scores

Petition to Make Special	Track One	Accelerated Exam	First Action Interview	Patent Prosecution Highway
No additional fee	\$4,000	\$140	No additional fee	No additional fee
Only certain claims and people	4 Independents, 30 Total	3 Independents, 20 Total	3 Independents, 20 Total	Claims match foreign allowable application
No support documents	No support documents	Preexam search and exam support document	No support documents	Entry based on at least 1 foreign allowed claim
No special interview	No special interview	Examiner interview required	Examiner interview required (opt out available)	No special interview
Score: 28/40	Score: 36/40	Score: 7/40	Score: 24/40	Score: 31/40

“Patent Expediting” Medal Podium



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Obrigada! Thank you!

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