

Fast Track Patent Examination

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Building a patent portfolio is an important part of new product development. For many startups, patents help credential their technology and attract investment. However, backlogs at the U.S. Patent and Trademark Office (USPTO) can delay the grant of a patent by years. To deal with this delay, mechanisms to fast track patent examination have become important tools to rapidly build a patent portfolio in the U.S.

Options Prior to Examination

1. Track One - Prioritized Examination

(<http://www.uspto.gov/patent/initiatives/usptos-prioritized-patent-examination-program>)

- The Leahy-Smith America Invents Act (AIA) established a new expedited patent review program called Track One or Prioritized Examination. Unlike prior initiatives, Track One has a lower burden on applicants, essentially only requiring that they pay an additional fee for the opportunity to receive a final disposition of an application (e.g., a Final Rejection or Notice of Allowance) within the USPTO’s goal of 12 months from the grant of prioritized status. Current statistics from the USPTO show that the Track One program far exceeds this goal.

Requirements	<ul style="list-style-type: none"> • Track One Request Form PTO/AIA/424 • Payment of all application filing fees and Track One fees • Must be filed electronically by EFS-Web if a utility application or by paper if a plant application • Request can be filed at the time of filing or with a Request for Continued Examination (RCE) • Can be made in an original or continuation utility application filing, but cannot be submitted with a national stage filing from a Patent Cooperation Treaty application • May not contain or be amended to contain more than 4 independent claims, more than 30 total claims, or any multiple dependent claims • Annual limit of 12,000 accepted requests
Cost	<p><u>Application Filing Fees</u></p> <ul style="list-style-type: none"> • \$300 basic filing fee (\$70 for electronic filing by small entity) • \$660 search fee (\$330 for small entity) • \$760 examination fee (\$380 for small entity) <p><u>Track One Fees</u></p> <ul style="list-style-type: none"> • \$4,000 Track One examination fee (\$2,000 for small entity) • \$140 Track One processing fee (\$70 for small entity) <p>Total Fees = \$5,860* (\$2,850 for small entity) *Plus any additional application size fees</p>

Advantages	<ul style="list-style-type: none"> • Can be used to receive a Notice of Allowance or first Office Action on the merits quickly <ul style="list-style-type: none"> ◊ Average time from filing Track One request to grant of request = 1.2 months ◊ 94% of requests are granted ◊ Average time from grant of Track One request to first Office Action on the merits = 1.7 months ◊ Average time from grant of Track One request to Notice of Allowance = 5.4 months ◊ Average time from grant of Track One request to Final Disposition = 6.6 months ◊ On the average, final dispositions are approximately 50% Notices of Allowance and 50% Final Rejections • No need to conduct a prior art search
Disadvantages	<ul style="list-style-type: none"> • Limited to 4 independent claims, 30 total claims and no multiple dependent claims • Can only request at the time of application filing or with a RCE • Not available for design applications or national phase applications at the time of filing • Prioritized status is lost if an extension of time is taken • Number of accepted requests is limited to 12,000 per fiscal year

2. Patent Prosecution Highway (PPH) – Global / IP5 PPH Pilot Program

(<https://www.uspto.gov/patents-getting-started/international-protection/patent-prosecution-highway-pph-fast-track>)

Requirements	<ul style="list-style-type: none"> • <u>U.S. application is eligible for PPH if:</u> <ul style="list-style-type: none"> ◊ An indication of allowable subject matter in a related application from a partnering PPH office has been received; ◊ The application with the indication of allowable subject matter and the U.S. application share a common earliest priority date; and ◊ Examination has not begun in the U.S. application. • Submit a PPH Request Form • If not available from certain websites, evidence of the positive examination results, the cited references in the related application, and their English translations may need to be submitted • A statement that the claims “sufficiently correspond” to the allowed claims serving as the basis for the request, along with an “explanation regarding the correspondence” • Must be filed by EFS-Web
Costs	<ul style="list-style-type: none"> • No additional fee required
Advantages	<ul style="list-style-type: none"> • Ability to leverage positive examination results in one country to reach a final disposition of a corresponding application in other countries more quickly and efficiently than standard examination processing • Can be used in conjunction with fast track programs available in the U.S. or elsewhere to build a global patent portfolio quickly • <u>An international PCT application or application from the following patent offices can form the basis for PPH:</u> <ul style="list-style-type: none"> ◊ Argentina, Australia, Austria, Brazil, Canada, Chile, China, Colombia, Czech Republic, Denmark, Estonia, Eurasia, Europe, Finland, Germany, Hungary, Iceland, Israel, Japan, Korea, Mexico, Nicaragua, New Zealand, Nordic Patent Institute, Norway, Peru, Philippines, Poland, Portugal, Romania, Russia, Saudi Arabia, Singapore, Spain, Sweden, Taiwan and United Kingdom, Visegrad Patent Institute • Average time from filing request in USPTO to decision on request = 72 days • 77% of petitions in USPTO are granted • High allowance and first action allowance rates compared to non-PPH applications • Prioritized status is not lost if an extension of time is taken • Lowers prosecution costs • See statistics: <ul style="list-style-type: none"> https://www.uspto.gov/sites/default/files/documents/PPH%20Quarterly%20Statistics%20Data_Year%202018.pdf

Disadvantages	<ul style="list-style-type: none"> • Substantive examination will still occur - the USPTO could identify new prior art and make new rejections • Allowed claims from a utility model or innovation patent from a country other than Korea cannot be used as the basis for the request • Developing U.S. claims that “sufficiently correspond” to the allowed claims serving as the basis for the request could be challenging in view of the differences in claiming style between countries • The allowed claims serving as the basis for the request could be broader or narrower than the desired scope for the U.S. • Provisional applications, plant applications, design applications, reissue applications, reexamination proceedings, and applications subject to a secrecy order are not subject to participation in the PPH program
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3. Full First Action Interview Pilot Program

(<http://www.uspto.gov/patent/initiatives/first-action-interview/full-first-action-interview-pilot-program>)

- Promotes personal interviews between the applicant and examiner before a first Office Action is issued
- After a request is filed, the examiner will conduct a prior art search and issue a Pre-Interview Communication, setting a one month (30 day) time period to request or decline an interview. This deadline is extendible for one additional month (30 days) with the payment of an extension of time fee of \$200 (\$100 for small entity, \$50 for micro entity)
- If agreement is not reached at the interview, the applicant will receive an Office Action and interview summary

Requirements	<ul style="list-style-type: none"> • Request to participate must be filed at least one day before a first Office Action, Notice of Allowance or Ex Parte Quayle action is mailed • Application must contain 3 or fewer independent claims, 20 or fewer total claims, and no multiple dependent claims • Must be filed by EFS-Web
Cost	<ul style="list-style-type: none"> • No additional fee required
Advantages	<ul style="list-style-type: none"> • Advances examination of applications once taken up in turn • Facilitates resolution of issues for timely disposition of an application • Program is open to all technology areas and application filing dates • Has a first action allowance rate of 29% versus 14% for applications not in the program
Disadvantages	<ul style="list-style-type: none"> • <u>Applicant agrees to:</u> <ul style="list-style-type: none"> ◊ Make an election without traverse if the USPTO determines the claims are not directed to a single invention ◊ Not request a refund of the search fee or any excess claims fee paid after the mailing or notification of the Pre-Interview Communication ◊ Not expressly abandon the application after the mailing or notification of the Pre-Interview Communication • Reissue applications are not eligible

4. Collaborative Search Pilot Program

(<http://www.uspto.gov/patents-getting-started/international-protection/collaborative-search-pilot-program-csp>)

- Purpose is to provide search results from two patent offices (USPTO and JPO or KIPO) early in the examination process so the applicant can determine their next steps in patent prosecution

Requirements

- Applicant consents to permit the USPTO and its partner Offices (JPO and KIPO) to share information
- Claims limited to 3 independent/20 total, and directed to a single invention

- Claims must correspond between Offices
- Earliest priority date must be post-AIA (March 16, 2013)
- Application must be unexamined in both Offices
- Granted Petition in both Offices
- Expires in November 2020, but may be extended
- **Potential Benefits According to the USPTO**
 - ◇ Greater consistency in examination across patent offices, leading to more certainty of intellectual property rights
 - ◇ Application is taken out of turn, resulting in expedited search results and final disposition
 - ◇ No additional fee required
- **The JPO-USPTO Pilot Program**
 - ◇ The USPTO and Japanese Patent Office (JPO) will exchange search and evaluation results identifying the best prior art and provide a work product that incorporates the efforts of the two patent offices
 - ◇ Limited to 200 applications per year, per patent office

<https://www.uspto.gov/sites/default/files/documents/JPOUSPTO%20Pilot.pdf>

- **The KIPO-USPTO Pilot Program**
 - ◇ The USPTO and Korean Intellectual Property Office (KIPO) will conduct two independent searches and provide both work products to the applicant for consideration
 - ◇ Limited to 200 applications for each patent office

<https://www.uspto.gov/sites/default/files/documents/KIPOUSPTOCSP.pdf>

5. Petition to Make Special

“Special” status and fast track examination are granted where Applicant (i) is at least 65 years old or (ii) has poor health.

(<http://www.uspto.gov/patents-application-process/petitions/23-make-special-age-and-health>)

- **Requirements:**
 - ◇ File a petition and submit evidence showing that (i) the state of health of the applicant is such that he or she might not be available to assist in the prosecution of the application if it were to run its normal course, such as a doctor’s certificate or other medical certificate, or (ii) the applicant is 65 years of age or more
 - ◇ **Note:** Any personal/medical information submitted as evidence to support the petition will be available to the public, unless submitted in compliance with MPEP 724.02
 - ◇ Not available to international applications that have not entered the national stage, design applications, reissue applications, provisional applications, or reexamination proceedings
 - ◇ No additional fee required
 - ◇ See MPEP 708.02
 - ◇ Timelines are similar to PPH, roughly 6-7 months to First Action

6. Accelerated Examination

(<http://www.uspto.gov/patent/initiatives/accelerated-examination>)

- Fast examination is also granted for performing a pre-examination prior art search
- USPTO’s goal is to complete examination within 12 months
- **Requirements**
 - ◇ File petition and fee
 - ◇ Must conduct a pre-examination search that meets certain requirements and provide an accelerated examination support document that discusses the results and patentability of the claims
 - ◇ Must agree to an interview with the examiner and elect a single invention without traverse, if needed
 - ◇ Application must contain no more than 3 independent claims and 20 total claims
 - ◇ Must be filed by EFS-Web
- **Recommendations**
 - ◇ Generally not recommended in view of the other available options that do not require a prior art search and

Options After Examination

1. After Final Consideration Pilot 2.0

(<http://www.uspto.gov/patent/initiatives/after-final-consideration-pilot-20>)

- Designed to enhance communication between the USPTO and applicant after issuance of a Final Rejection closing examination
- Authorizes additional time for examiners to search and/or consider applicant responses
- To be eligible, must file a response to a Final Rejection that includes a request for consideration under the pilot and an amendment to at least one independent claim that does not broaden its scope
- Must agree to have an interview
- Must be filed by EFS-Web
- No additional fee required
- Currently projected to end September 30, 2020, but may be extended

2. Pre-Appeal Brief Conference Programs

(https://www.uspto.gov/web/offices/pac/mpep/s1204.html#ch1200_d1fc9d_147da_3d)

- When a notice of appeal is filed in an application, the appellant may also request a Pre-Appeal Brief Conference
- Intended for applications where there are either (1) clear errors of fact in the examiner's rejections or (2) omissions of one or more essential claim elements that are needed to establish a prima facie rejection of the claims
- Once filed, the request is reviewed by a panel that consists of a supervising examiner, another examiner and the examiner of record
- Appellant must file a short memo (no more than 5 pages) in support of their request which is reviewed by the panel at the conference
- No additional fee required
- The panel can (1) allow the appeal to proceed to the Patent Trial and Appeal Board ("PTAB"), (2) allow the application, or (3) reopen examination
- Program may avoid the expense of a lengthy appeal process

3. Quick Path Information Disclosure Statement Pilot Program

(<http://www.uspto.gov/patent/initiatives/quick-path-information-disclosure-statement-qpids>)

- Eliminates the requirement for processing of an RCE with an information disclosure statement (IDS) filed after payment of the issue fee in order for the IDS to be considered by the examiner
- No additional fee required
- If no item of information in the IDS necessitates reopening examination, the USPTO will issue a corrected notice of allowability
- Must include a statement that the references in the IDS were first cited in a communication from a foreign patent office in a counterpart foreign application not more than 3 months prior to the filing of the IDS

4. Ombudsman Pilot Program

(<http://www.uspto.gov/patent/ombudsman-program>)

- Application-specific prosecution assistance when the normal channels have not provided the timely assistance needed (e.g., a communication barrier between applicant/attorney and examiner or when there is prolonged prosecution)
- A request is made by submitting an electronic form on USPTO's website
- An ombudsman assigned to the technology center for the application will then contact the requestor by telephone within one business day
- Telephone communication is encouraged, as written communications regarding the merits of an application will be placed in the application file
- No additional fee required

Other Tips on When to Use Fast Track Examination

- Fast and efficient patent portfolio creation
 - ◇ Startups seeking investment
 - ◇ Shield against known competitors
 - ◇ Sword for entry into new space
 - ◇ Meet in-house or investor expectations on numbers of patents
- Tool for patent litigation
 - ◇ Obtain additional patents to assert against competitor
 - ◇ Increase leverage during settlement negotiations
- If parent patent(s) is involved in an *Inter Partes* Review
 - ◇ Obtain additional claims before any patent owner estoppel attaches
 - ◇ Easier to amend claims during prosecution

Sterne Kessler has filed over:

268 – Track One Original Applications
310 – Other Track One Applications (includes CONs, DIVs, and CIPs)
147 – First Action Interview Requests
214 – Track One RCEs (Track One applications that include an RCE in the file history)
115 – PPH Requests (USPTO PPH decisions)
1000+ – After Final Consideration Pilot 2.0 Requests

[Source: Juristat]