

Fast or Slow?

Strategies to Speed Up the Patent Process Among Worldwide Patent Offices

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A threshold question for each patent filing is the speed at which a patent is desired.

In many cases, applicants want to obtain patent protection as rapidly as possible in order to guard against infringers or as a show of success to potential investors. In these situations, there are a variety of mechanisms available including: petitions to advance examination in the United States (*e.g.*, a petition to make special); and accelerated requests for search and examination in foreign jurisdictions such as Europe or the United Kingdom.

In other situations, a client may desire to obtain a patent at the normal pace of the various patent offices. For example, proceeding to issuance at a slower pace can allow applicants time to develop and plan the commercialization and marketing of their invention. In this situation, a client can choose to file a U.S. provisional application, followed by a Patent Cooperation Treaty (“PCT”) application and then various nationalization stage applications. This strategy can extend the time to issuance significantly in comparison with the available acceleration strategies.

On average, a patent filing in the U.S. Patent and Trademark Office (“USPTO”) takes just over two years for a first office action to be generated and about three years until a final disposition is made (*e.g.*, allowance or abandonment). See www.uspto.gov/dashboards/patents/main.dashxml.

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Currently, the overall allowance rate for the USPTO is about 46% and the rate without Requests for Continued Examination, which are counted as abandonments, is 60%.

USPTO: PATHWAYS TO APPLICATION ADVANCEMENT

There are presently several routes available in the United States to fast track an application. These include petitions: based on age/health of an inventor; under the Green Technology Pilot Program; to make special under the revised accelerated examination Program; or under the Patent Prosecution Highway (“PPH”). Also, the USPTO Project Exchange program, which is designed to help reduce the application backlog at the USPTO, is available until the end of 2011.

Age/Health of an Inventor: An application is eligible for this program if an inventor is age 65 or older or in poor health. A statement is required attesting to the age or health of the inventor eligible for this process. See U.S. Pat. & Trademark Office, U.S. Dep’t of Commerce, Manual of Patent Examining Procedure § 708.02 (IV) (8th ed., 8th rev. 2010) [hereinafter MPEP].

The Green Technology Pilot Program: This program was first announced by the USPTO in 2009 and is scheduled to run until Dec. 31, 2011. Recently, the USPTO broadened the pilot program to provide faster examination of certain “green technology” patent applications regardless of filing date. However, only the first 3,000 petitions that meet the requirements to participate in the green technology pilot program will be accepted. See www.uspto.gov/patents/init_events/green_tech.jsp. According to recent USPTO sources, 1,595 requests have been filed by applicants for the program, and 790 of those have been granted.

The Revised Accelerated Examination Program: This program is generally available for any application but requires that the applicant conduct a pre-examination search and provide the USPTO a pre-examination support document. See MPEP § 708.02(a). These requirements are generally viewed as being quite burdensome and of uncertain impact on prosecution of future applications or potential litigation.

The Project Exchange Program: This temporary program allows an applicant with more than one application to expedite review of one application by withdrawing another unexamined application. See www.uspto.gov/patents/init_events/PatentStimulusPlan.jsp. In October 2010, it was expanded to include both large and small entity applicants. However, it is limited to 15 applications per entity and currently expires on Dec. 31, 2011.

Of course, in any case, prosecution can be advanced significantly by filing a U.S. Utility application in the first instance, skipping the process of filing a provisional patent application.

THE PATENT PROSECUTION HIGHWAY

An increasingly attractive option for applicants is to make use of the PPH. The PPH is a series of bilateral agreements that enable an applicant who received notice of at least one allowable claim from a patent office of first filing (“OFF”) to expedite examination in an office of second filing (“OSF”). This can lead to cheaper and faster global patent coverage. In addition to the original PPH, there is also the PCT-PPH, which allows one to leverage a “clean” Search Report from a PCT (performed by a participating jurisdiction, such as the European Patent Office (“EPO”), Japan, Korea or the USPTO) to expedite an application through the PPH. The USPTO has agreements with several patent offices for the PPH, including the

EPO, Germany, Spain, Korea, the UK and others for the PCT-PPH. See www.uspto.gov/patents/init_events/pph/index.jsp.

In the USPTO, a request to participate in the PPH program must be filed with a petition to make special; however, no fee is required. Under the PPH process, there are numerous ways to enter into the program. In order to receive expedited examination in the United States as the OSF, one must have allowed claims from an OFF or a clean Search Report in a PCT. See www.uspto.gov/patents/init_events/pph/pph_faqs.pdf.

According to recent USPTO sources, just over 4,100 requests had been filed under the PPH. A first office action for an application filed under the PPH was received between two to three months after the PPH request was granted and more than 90% of the applications filed under the PPH were allowed.

The PPH process can be fairly complex and when the USPTO is used as the OSF most paths prevent an applicant from filing a U.S. provisional application, with the PCT-PPH being the exception. However, with careful execution it can dramatically reduce the time and cost to obtaining a U.S. patent.

PROGRAM FOR ACCELERATED PROSECUTION OF EUROPEAN PATENT APPLICATIONS

Under the Program for Accelerated Prosecution of European Patent Applications ("PACE"), an applicant can accelerate the search procedure, examination procedure or both for a European ("EP") application filed in the European Patent Office. See http://archive.epo.org/epo/pubs/oj010/06_10/06_3520.pdf. There are no special requirements to qualify for PACE, the request can be filed at any time and no official fee is required. However, a request under PACE is subject to the workload of the relevant search and examining division, which for some technologies can lead to constraints in how timely an application is examined. In practice, a modest decrease in time to first examination has been observed in complex technologies, such as the life sciences. In some technologies, it has been observed that applications filed under PACE are searched within six months from filing of a request and an examination report can be received within three months.

It is generally advisable to file a PACE request along with an EP application, as it is not uncommon for the normal examination process to last five to seven years before an application is granted by the EPO. While it is possible to use the EPO as an OFF under the PPH of PCT-PPH, there are some drawbacks to this approach. Even under the PACE process, examination in Europe can be lengthy and more formal than in the United States and other countries. For example, unlike in the United States and the UK, a meeting between the applicant and the Examiner is much more formal and of greater binding consequence. Also, the EPO has a formal opposition procedure in place, which allows a third party to tie up a patent in proceedings for years after it is granted.

DIRECT EUROPEAN FILINGS

Alternatively, an applicant can directly file an application in one or more European countries before, in conjunction with, or instead of filing an application with the EPO. For this strategy, it is wise to file in countries of economic importance to the applicant's underlying business. In Europe, countries with important markets and a PPH agreement with the USPTO include the UK, Germany and Spain. U.S. applicants should be aware that for non-English speaking countries, translation costs can significantly increase the cost of prosecution. Also, the United States requires that an applicant obtain a foreign filing license if the invention was made in the United States before first filing abroad. This license can generally be obtained within two or three days after a request is made. For many U.S. applicants, the UK is one of the more important markets in Europe and has the added advantage that no translations are required.

ACCELERATED SEARCH AND EXAMINATION AT THE UK-IPO

In the UK, an application can be filed together with a request for a combined and accelerated search and examination. See www.ipo.gov.uk/p-fastgrantguide.pdf. When an accelerated prosecution request is granted, the United Kingdom Intellectual Property Office ("UK-IPO") typically issues a first examination report within two months and will continue to do so if the applicant responds in a timely manner. When early publication is also requested, it is possible to get a patent issued in

the UK in less than a year. The UK-IPO requires applicants to provide reasons why the request to accelerate should be accepted. Similar to the USPTO, the UK-IPO will typically grant such a request for "Green Technology" applications without additional justification. Other acceptable reasons include that applicant is aware of a potential infringer or a more rapid search, examination, or issuance is needed in order to gain an investor. For early stage companies, acquiring investment is frequently vital and can provide grounds for making a request for acceleration.

Given the rapid pace of examination under the accelerated examination procedure, one can potentially use the UK-IPO as an OFF, receive a notice of allowable claims in less than a year, file subsequent applications via the Paris Convention or the PCT and utilize the PPH process to expedite in other countries (*e.g.*, the United States). The UK application can be a first filing or the national stage of a PCT that has no priority claim. Using these approaches it is possible to rapidly obtain allowable claims in the UK, which can be used to demonstrate to potential investors the kinds of claims that will likely be obtained in other jurisdictions, such as the United States.

Unlike the EPO, the UK-IPO does not have an opposition procedure, which provides a greater degree of certainty to an applicant that any issued patent will remain in the form granted. By securing a UK patent, an applicant can protect its invention in a significant European market, free from the worry of opposition and in a faster manner than by filing an EP application alone.

CONCLUSION

There are several avenues open to applicants who want to speed up the time to allowance in the United States and abroad. However, many are procedurally complex and require advance thought on how to execute in view of larger business objectives.